

REMARKS/ARGUMENTS

Claims 1, 3, 5, 10, 11 and 14 to 17 are pending. Claims 1, 5, 16 and 17 have been amended.

The Office Action stated: that a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection; that, since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114; and that applicant's submission filed on October 30, 2007 has been entered.

Claims 1, 16 and 17 have been objected to because of the following informalities: in Claim 1, line 12, Claim 16, line 12, and Claim 17, line 11, "part of surface portion" is ungrammatical and should include an appropriate article; appropriate correction is required; in Claim 16, line 8, "substantially entire area" is ungrammatical and should be -- substantially the entire area--. Applicant has amended such claims in such manner.

This objection should be withdrawn.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,

Claims 1, 3, 5, 10, 11 and 14 to 17 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant traverses, in part, this rejection.

The Office Action stated that Claim 1, lines 5 and 6, "does not have any hole therein and is continuous and uninterrupted is indefinite, as such" repeats itself and is

redundant; and that the phrase should be --is continuous and uninterrupted so as to not have any hole therein--, or merely --is continuous and uninterrupted-- to be clear and unambiguous. Applicant has amended the claim using the first phrase. The Office Action stated also see Claim 16, lines 5 and 6. Such claim has also been amended in such manner.

The Office Action stated: that in Claim 1, line 8, "printed on one of one side or both sides" is indefinite, as it is unclear whether "one" is one side only or if the option includes both sides being printed; and that the phrase "one of one or both sides" is indefinite, as one of one side is one and one of both sides is one, while ---printed on one or both sides-- is clear of an alternative being defined. Applicant has amended such claim in such manner. The Office Action stated see also Claim 5, lines 6 and 7, Claim 16, line 8, and Claim 17, lines 7 and 8. Such claims have been amended in such manner.

The Office Action stated that in Claim 16, line 8, "substantially entire area of the cover" is misleading, as such renders "a remaining portion of the cover film is permanently bonded" inconsequential, as the peelable area is just about the entire area and the permanently bonded area is accordingly inconsequential. Applicant traverses the statement. The permanently bonded area is not inconsequential as it is a crucial portion of the invention, that is, it provides a small area of the surface for permanent bonding of the peelable portion thereto allowing the peelable portion to be swung out for reading of the backside thereof. Moreover, a large area is not required for such crucial matter of achieving the crucial permanent bonded. The phrase "substantially entire area of the cover" is not misleading and the Examiner has not shown otherwise.

The Office Action stated that, however, the disclosed peelable "entire area of the cover is not "substantially all" of the area, as such is demonstrated to be a substantial, but not for all intents and purposes, practically all of the area. Applicant traverses this statement and has shown that it is incorrect. The Examiner has not factually

demonstrated his assert in the record. In fact, applicant has demonstrated that it is in error. Webster's Ninth New Collegiate Dictionary, (1989), states:

“substantial...3...b : considerable in quantity : significantly large...5 : being largely but not wholly that which is specified...” [Page 1176]

“largely...: to a large extent : **mostly, primarily**” [Page 674]

“mostly...: for the greatest part : **mainly**” [Page 774]

The term “entire area” further defines and emphasizes the small, but crucial, area where there is permanent bonding, and defines such area as being smaller (but crucial and consequential) the term “substantial” by itself would allow. Applicant's several drawings readily and clearly support applicant's position and show that the Examiner's assertion is in error.

This rejection should be withdrawn.

The Office Action stated that the following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the Invention is not identically disclosed or described as set forth In section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 10 and 14 to 17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Counts et al. (U.S. Patent No. 5,341,930) in view of Kaufmann (U.S. Patent No. 5,389,415). Applicant traverses this rejection.

The Supreme Court's Graham and KSR decisions and Patent Office policy require that the level of ordinary skill in the pertinent art be resolved, as well as two other factual inquiries be determined, before any decision of obviousness can be made. These three mandatory factual inquiries and their mandatory determination form the required foundation before secondary considerations can be considered and any determination of obviousness made. The Examiner has not made the required factual inquiry and resolving in the record of the level of ordinary skill in the pertinent art. Therefore, all of the obviousness rejections in the Office Action fail and are defective on their face. The Examiner has the burden of proof and he has not carried his burden. Accordingly, the Examiner has not demonstrated in the record any showing of prima facie obviousness. Applicant requests that the failed obviousness rejections in the Office Action be withdrawn.

The Office Action stated that Counts et al. discloses a packaging bag (Figures 1 and 2) with a front wall (14) and a rear wall (12) in which the front wall and rear wall are bonded together along a peripheral edge (column 6, lines 39 to 47), each of the front wall and the rear wall being continuous and uninterrupted so as to not have any hole therein, at least one of the front wall and rear wall bonded to a cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and at least one of the front wall and rear wall of the packaging bag printed on the outside of the bag (at 20). Applicants traverse this rejection as being incorrect and incomplete. Counts et al. does not have any portion of a cover film that is permanently bonded to any portion of a packaging film. This factor alone directs one ordinarily skilled in the art away from applicant's claimed invention. Permanent bonding inserted into Counts et al. would destroy the invention of Counts et al. which is one of the reasons why Counts et al. is not

a relevant reference, why one ordinarily skilled in the art would throw away counts in the search for applicant's invention, and would not combine Counts and Kaufmann.

The Office Action stated that Kaufmann discloses a substantial portion of a cover film (2) bonded to and peelable from a package and a remaining portion (5) of the cover film permanently bonded to a packaging bag in an edge area. Insertion of Kaufmann into Counts et al would destroy the Counts et al. invention, which would direct one ordinarily skilled in the art away from using a combination of such rejection references in the quest for applicant's claimed invention. All of the prior art teachings of record have to be considered under Section 103(a), even prior art teachings which destroy (as here) the attempted obviousness rejection.

The Office Action stated that "To employing would have been obvious in order to it" would have been obvious to one of ordinary skill in the art at the time the invention was made to provide modify the packaging bag of Counts at al. with the peelable and permanent seal combination teaching of Kaufmann as claimed, as such a modification would predictably permanently retain the cover film with the bag of Counts at al., yet allows its partial peeling to ascertain text hidden beneath the cover film, as suggested by Kaufmann: "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." KSR Int 'l v. Teleflex Inc., 127 S.Ct. 1731, 82 USPQ2d at 1396. Applicant traverses this statement. The Examiner has not resolved in the record the level of ordinary skill in the art so the Examiner does not know what would be obvious to one ordinarily skilled in the art. The Examiner has not shown why one ordinarily skilled in the art would combine a secondary reference with a primary reference where the result is destruction of the invention of the primary reference.

The Examiner's above mentioned quotation from the KSR decision is of no importance regarding applicant's claimed invention because the Examiner has not

established in the record the mandatory foundation before he can go forward under Section 103(a). The Examiner has no basis for asserting obviousness.

The Examiner has not shown that Claim 1 is obvious.

The Office Action stated that, as to Claim 2, Counts et al. discloses a first packaging film (14), a second packaging film (12) and a cover film (16). The independent claim is not obvious so the dependent claim is not obvious.

The Office Action stated that, as to Claim 10, Counts et al. discloses bonding of the cover film in an edge area. The dependent claim cannot be obvious for the above reason.

The Office Action stated that, as to Claim 14, Kaufmann further discloses employing permanent adhesive (see column 2, lines 43 to 55). The dependent claim cannot be obvious for the above reason.

The Office Action stated that as to Claim 15, since the prior art combination discloses printing in general, and applicant discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment. The Examiner does not know what would be obvious to one ordinarily skilled in the art. The dependent claim cannot be obvious for the above reason.

This rejection should be withdrawn.

Claims 3 and 11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to Claim 1 above, and further in view of Muir et al. (U.S. Patent No. 6,767,604). Applicant traverses this rejection. The independent is not obvious so these dependent claims are not obvious.

Muir et al. does not cure the defects of either Counts et al. or Kaufmann, or a combination of them in the search for applicant's claimed invention. Muir et al. does not

cure the reasons why one ordinarily skilled in the art would not combine Counts et al. and Kaufmann in the search for applicant's claimed invention.

The Office Action stated: that Muir et al. discloses the front wall and the rear wall of a similar bag being of the same packaging film by folding (see column 3, lines 46 to 61); and that to provide the front and rear walls of Counts et al., as folded portions of the same material would have been obvious, as it is well-known in the bag field to provide a bag by folding a single sheet, as disclosed by Muir et al. Applicant traverses the statement because it is meaningless under Section 103(a) ("obvious" to whom?).

This rejection should be withdrawn.

The Office Action stated that applicants' arguments with respect to Claims 1, 3, 5, 10, 11 and 14 to 17 have been considered but are moot in view of the new grounds of rejection. The new obviousness rejections also fail.

The Office Action stated: that in response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references; and See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co*; 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.1986). This statement and the cited decision are of no meaning in the case at bar because applicant argued against the combination of the rejection references in the quest for applicant's claimed invention.

The Office Action stated that applicant maintains to believe that any modification of one reference with the teaching of another "destroys" the modified reference. This statement is not a correct or accurate statement of applicant's position. Applicant stated that insertion of Kaufmann into Counts et al. would destroy the Counts et al. invention (which the Examiner has not shown to be wrong). This does not involve mere "modification" or "any modification" – instead it involves "destruction".

The Office Action stated that this argument can be used for any construction, as employing applicant's rationale, any change in an existing structure "destroys" the existing structure. This statement has nothing to do with applicant's position. Mere modification is not the same as destruction. The Office Action stated that neither the Examiner, nor the Patent Office, recognizes that any modification destroys a base reference by it merely being modified. This statement has nothing to do with applicant's position that destruction of an invention by insertion of another reference would cause one ordinarily skilled in the art to reject use of such references in the search for applicant's claimed invention. The Office Action stated that thinking in a common sense way, would replacing a container with an entirely removable closure on a container with a hinged or tethered closure "destroy" the container? This statement is not even pertinent. The Office Action stated that, in the Examiner's vision, it would just change the capabilities of the container in an expected way. This statement is also not pertinent to the case at bar.

The Office Action stated that the modification of Counts et al. in view of Kaufman is also maintained to be obvious in order to obtain a non-removable cover. The statement is incorrect. Also, it would be "obvious" to whom – this standard has nothing to do with Section 103(a).

The Office Action stated that the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. This statement is of no effect in the case at bar. The Examiner has not resolved in the record the level of ordinary skill in the art so the Examiner does not know any thing about one ordinarily skilled in the art. The Office

Action stated See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.1992). This citation of this CAFC decision is meaningless and does not apply to the case at bar because the Examiner has not made all of the mandatory determinations of fact required by the Supreme Court decisions and Patent Office policy. The Office Action stated that, in this case, Kaufman discloses a printed cover film being reusably peelable from a bag and resecurable thereto, to render the packaging bag recoverable by the printed cover film, which is what is desired by applicant in his packaging bag. This statement is meaningless under Section 103(a). The Examiner has not factually resolved in the record the level of ordinary skill in the art. The primary reference is Counts et al. and insertion of Kaufmann into Counts et al. destroys the invention of Counts et al. All of the prior art teachings of record must be considered under Section 103(a).

The Office Action stated that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Note that the Examiner has not resolved in the record the level of ordinary skill in the art. The obviousness rejections fail on this ground alone.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

Date: June 11, 2008

Virgil H. Marsh
Virgil H. Marsh
Reg. No. 23,083

Fisher, Christen & Sabol
1725 K St., NW
Suite 1108
Washington, DC 20006
Tel.: 202-659-2000
Fax: 202-659-2015
fcsabol@aol.com

<p><u>CERTIFICATE OF MAILING</u> I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on <u>June 11</u>, 2008. <u>Virgil H. Marsh</u> FISHER, CHRISTEN & SABOL 1725 Street, N.W., Suite 1108 Washington, D.C. 20006</p>
--